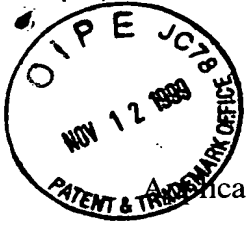


GAU2853 AF

Dkt. 2271/45006-A



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant of : Takuro SEKIYA

Serial No. : 08/547,904                      Group Art Unit: 2853

Date Filed : October 25, 1995                      Examiner: J. Nguyen

For : INKJET RECORDING HEAD ADAPTED FOR IMPROVED  
PRECISION OF MOUNTING

1185 Avenue of the Americas  
New York, N.Y. 10036

**SUBMISSION OF APPELLANT'S REPLY BRIEF**

Sir:

Applicant hereby submits an original and three copies of an Appellant's Reply Brief replying to the Examiner's Answer dated September 7, 1999.

Please charge any fees that may be needed in connection with this paper to our Deposit Account No. 03-3125.

Respectfully submitted,

RICHARD F. JAWORSKI

Reg. No.33,515

Attorney for Applicant

Cooper & Dunham LLP

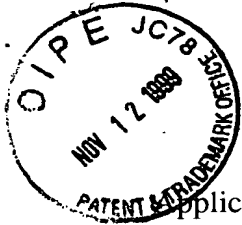
Tel.: (212) 278-0400

I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.	
	Nov. 8, 1999
Richard F. Jaworski	Date
Reg. No. 33,515	(Monday)

TO 2003 MAIL ROOM

NOV 15 1999

RECEIVED



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application of : Takuro SEKIYA

Serial No. : 08/547,904                      Group Art Unit: 2853

Date Filed : October 25, 1995                      Examiner: J. Nguyen

For : INKJET RECORDING HEAD ADAPTED FOR IMPROVED  
PRECISION OF MOUNTING

1185 Avenue of the Americas  
New York, N.Y. 10036

APPELLANT'S REPLY BRIEF

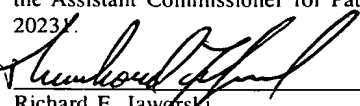
Sir:

Adjustment date: 11/30/1999 RPRESTON 08547904  
11/17/1999 VBROWN2 00000001 033125  
01 FC:120 300.00 CR

RECEIVED  
NOV 16 1999  
TO 2000 MAIL ROOM

Applicant has not made alleged admissions as suggested in the Examiner's Answer.

In addition, the Examiner's Answer impermissibly makes new rejections and cites art not present in the Final Office Action in words or substance. Applicant has not had a fair opportunity to seek to overcome them by argument and/or claim amendment, and respectfully requests that the Board disregard or dismiss them.

I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.	
	NOV. 8, 1999
Richard F. Jaworski	Date
Reg. No. 33,515	(Monday)

**B. DISCUSSION**

**1. Applicant Has Not Made Admissions as Suggested in Examiner's Answer**

The Examiner's Answer at the bottom of page 4 - top of page 7, suggest that Applicant has not argued certain claimed features before and that this is somehow an admission that the features are well known in the art.

More specifically, in several sections of the Examiner's Answer, the Examiner contends that Applicant must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the cited references. The Examiner goes on to contend that since appellant has never argued certain features before, it is considered Appellant's own admission that the feature is well known in the art. However, the Examiner has failed to provide any rational basis of support for this contention.

It is noted that the Rules do not require Applicant to specify each and every claim element that distinguishes over cited art. The Rules noted by the Examiner simply require that a reply present arguments pointing out specific distinctions believed to render the claims patentable over any applied references (see 37 C.F.R. §1.111). The Rules are not believed to require Applicant to specify in each response, each and every claim element that distinguishes over cited art. There is believed to be nothing in the Rules to suggest that any claim feature not specifically argued is somehow an admission that the feature is prior art.

In any event, Applicant has argued these features previously. For example, the last paragraph of page 13 - top of page 14 of the Appellant's Brief indicate that the cited art fails to teach making electrical contact between electrode contacts on the recording head unit and electrode contacts on the carriage, as recited in claim 12. Arguments to this effect were

made in the Amendment After Final Rejection filed August 14, 1998 and entered by the Examiner (e.g., see pages 5-6 of the Amendment After Final Rejection). Regarding the recitation in claim 12 of removing the seal member such that the interior space of the ink reservoir communicates with an exterior of the ink reservoir via a vent, this feature was previously argued in the Amendment filed September 2, 1997.

**2. Arguments Not Present Prior to Examiner's Answer**

Applicant respectfully requests that the Board disregard the new rejections and art included in the Examiner's Answer, because 37 C.F.R. §1.193(a)(2) and MPEP §1208.01 prohibit the entry of a new ground of rejection in an examiner's answer

Applicant has not had a fair opportunity to address those new rejections. Had they been made timely, applicant could have sought to overcome them by argument and/or claim amendment but cannot do so now as prosecution is closed.

Regarding the rejection of claim 12, the Examiner cited Cowger in the previous Office Actions as teaching or suggesting removing the seal member such that the interior space of the ink reservoir communicates with an exterior of the ink reservoir via a vent. However, the previous Office Actions do not indicate specifically where in Cowger this feature is allegedly found. The Examiner has now suggested for the first time, that this feature is somehow "inherent" in Cowger. This inherency argument is being presented for the first time in the Examiner's Answer. Accordingly, Applicant was not previously given the opportunity to rebut such assertion and demand evidence supporting the same as allowed by the Rules (see MPEP § 2144.03).

In addition, Japanese document 5-162326 to Wada was cited for the first time in the Examiner's answer and is a new ground of rejection, clearly not permitted by the Rules . Wada was not added merely as evidence of a prior well known statement made by the Examiner, and thus constitutes a new ground of rejection (see MPEP §1208.01). The Examiner never previously argued that the removable seal member was well known in the art, other than to state that it would have been obvious at the time the invention was made to one of ordinary skill in the art to incorporate the vent with the removable seal member of Cowger et al. in Kashimura et al. for the purpose of providing ambient air communication to the ink reservoir (See Final Office Action dated November 25, 1997, pages 3-4). The Examiner's new contention (and the cited Wada reference in support thereof) that the removable seal member is inherent is clearly a new issue impermissibly raised for the first time in the Examiner's Answer.

The previous Office Actions also did not allege that making the head and the ink tank detachable from each other was notoriously well known in the art. However, the Examiner's Answer now states that it was notoriously well known in the art to have the head and the ink tank detachable from each other. The Examiner's new contentions regarding what was allegedly notoriously well known in the art and the newly cited Wada reference in support thereof are new grounds of rejection, and not permitted by the Rules.

### C. CONCLUSION

For the reasons discussed in Applicant's opening and reply briefs, Applicant respectfully requests the Board not sustain the rejections maintained in the Examiner's

answer and not consider or dismiss the new rejections included therein.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Richard F. Jaworski", written over a horizontal line.

RICHARD F. JAWORSKI

Reg. No. 33,515

Attorney for Applicant

Cooper & Dunham LLP

Tel.: (212) 278-0400